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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/656,414	09/06/2000	Hiroshi Tamura	2271/63036	9526

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New York, NY 10036

EXAMINER

GRANT II, JEROME

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/656,414

Applicant(s)

TAMURA, HIROSHI

Examiner

Jerome Grant II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-28 and 38-45 is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-13, 17, 19 and 29-37 is/are rejected.
- 7) ☒ Claim(s) 7, 8, 14-16, 18 and 20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JEROME GRANT II
PRIMARY EXAMINER

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

1.

Detailed Action

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims have been amended to recite "an e-mail message to a facsimile device by facsimile transmission over the telecommunication network that is not the Internet." The written specification and the drawings does not support this new claim limitation.

Correction is required.

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2.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 12, 29-33 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Iwazaki.

With respect to claim 1, Iwazaki teaches Internet facsimile gateway device (3, 4, 5 and 11) connected to a telecommunication network 13 and the Internet, comprising: an image transmitting unit 11 that transmits image information included in an electronic mail message S9 (see figure 3) to a fax device 6, 7 or 8 when said Internet gateway device receives an Email message (from server 5) requesting image transmission to the fax device (from terminal device 103). Iwazaki teaches a delivery confirmation mail creating unit 26 that creates a delivery confirmation message as claimed. See col. 4, lines 31-41. Iwazaki teaches a delivery confirmation mail transmitting unit 25 that

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transmits the delivery confirmation mail message to the original address of the message. See S16 of figure 5 and col. 8, lines 25-35 and col. 10, lines 61-67

With respect to claim 2, Iwazaki teaches the delivery mail message is regulated by a DSN, see col. 1, lines 50-67. Iwazaki teaches a delivery confirmation creating unit that creates the message regulated by the DSN notifying a successful image transmission (see col. 8, lines 35-43) after the image information transmission by said Internet facsimile gateway device (3, 4, 5 and 11) is succeeded if said electronic mail message request said Internet gateway device to transmit the delivery conformation mail message regulated by the DSN notifying the successful image transmission to the original address of the E-mail.

With respect to claim 3, Iwazaki teaches the delivery message is regulated by the DSN (see col. 1, lines 50-67) and the delivery confirmation mail creating unit that creates the delivery confirmation message regulated by the DSN notifying a failed image transmission (see col. 7, lines 50-56) if the mail message requests said Internet gateway device to transmit the delivery confirmation mail message regulated by the DSN notifying the failed message to the originator of the message.

With respect to claim 4, Iwazaki teaches the delivery confirmation mail message is regulated by a MDN (col. 7, lines 40-56 and col. 8, lines 26-42) and the delivery confirmation mail creating unit 26 that creates the deliver confirmation message regulated by the MDN, see col. 7, lines 28-38, notifying the successful image

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transmission (col. 8, lines 26-42) after the image information transmission by said Internet facsimile gateway device (3, 4, 5 and 11) if the mail message requests said Internet fax to deliver a message to the originating address of a successful transmission.

With respect to claim 5, Iwazaki teaches the deliver mail message is regulated by the MDN, see col. 7, lines 40-56 and col. 8, lines 26-42; and the delivery mail creating unit creates the delivery mail message regulated by the MDN notifying the image (col. 7, lines 50-55) after the transmission by said Internet facsimile gateway device is failed, if said electronic mail message requests said Internet fax gateway device to transmit the mail message notifying a failed image transmission to the original address.

With respect to claim 6, this limitation is taught with respect to col. 9, lines 14-21 and col. 11, line 5 and col. 13, lines 30-35.

With respect to claim 12, Iwazaki teaches a mail creating unit 11 that creates the delivery confirmation message that notifies the result of the image transmission (col. 7, lines 40-56 and col. 8, lines 26-42), said result including reception ability information of the facsimile device received therefrom. Iwazaki teaches transmitting a successful transmission message to the original address (see S16 @ figure 5)

See also figure 6.

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With respect to claim 29, Iwazaki teaches a fax gateway device, comprising the steps of connecting a telecommunication network 11, 12 and the Internet 3; transmitting image information included in an electronic mail message to a fax device 6-8 when receiving said electronic mail message (see figure 6) requesting information transmission to the fax device; creating a delivery confirmation message via unit 26 and notifying the result of the completion of the transmission to be sent to an original E-mail address if a request is made. See unit 25 and figure 5 step S16. See also col. 8, lines 25-35 and col. 10, lines 61-67.

With respect to claim 30, Iwazaki teaches an E-mail message regulated by a DSN (see col. 1, lines 52-67) including the creation of a mail message via unit 26 regulated by the DSN after the mail message is successfully transmitted and if the E-mail message requests the Internet fax gateway to transmit the delivery confirmation mail message via unit 25 by the DSN (col. 1, lines 52-67) successful image transmission to the original address is performed.

With respect to claim 31, Iwazaki teaches a method of regulating a message by a DSN according to (see col. 1, lines 50-67). Iwazaki teaches the delivery confirmation mail creating unit that creates the delivery confirmation message regulated by the DSN notifying a failed image transmission (see col. 7, lines 50-56) if the mail message requests said Internet gateway device to transmit the delivery confirmation mail

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message regulated by the DSN notifying the failed message to the originator of the message.

With respect to claim 32, Iwazaki teaches wherein the confirmation mail message is regulated by a MDN (according to col. 7, lines 40-55) the method comprises the step of creating a delivery message regulated by the MDN notifying the successful image transmission after the transmission is successful, see col. 8, lines 35-42, to the originator of the E-mail message.

With respect to claim 33, Iwazaki teaches a method of controlling the Internet gateway device for creating an E-mail message which is regulated by the MDN, see col. 7, lines 40-56 and col. 8, lines 26-42; and the delivery mail creating unit creates the delivery mail message regulated by the MDN notifying the image (col. 7, lines 50-55) after the transmission by said Internet facsimile gateway device is failed, if said electronic mail message requests said Internet fax gateway device to transmit the mail message notifying a failed image transmission to the original address.

With respect to claim 37, Iwazaki teaches a mail creating unit 11 that creates the delivery confirmation message that notifies the result of the image transmission (col. 7, lines 40-56 and col. 8, lines 26-42), said result including reception ability information of the facsimile device received therefrom after transmitting a successful transmission message to the original address (see S16 @ figure 5). See also figure 6.

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-11, 13, 17, 19, 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwazaki.

With respect to claims 9-11, Iwazaki teaches all of the subject matter upon which the claim depends. Iwazaki teaches a network 13 for performing the E-mail service.

What is not specifically taught is the use of a GSTN, PSTN or ISDN. However, these networks are art equivalents for the purpose of transmitting E-mail messages from a sender to a receiver and would have been contemplated by one of ordinary skill in the art.

The examiner submits that it would have been obvious to one of ordinary skill in the art to replace the Internet 13 with anyone of GSTN, PSTN or ISDN networks, known in the art, for the purpose of transmitting E-mail messages.

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With respect to claims 13 and 17, figure 1 of Iwazaki clearly shows transmitting messages to an Internet Fax 6-8. It is not clear if the fax is a G2, G3 or G4 machine. However, since a fax machine is inclusive of a G3 machine, the Iwazaki reference contemplates the use of a G3 machine. Hence, it would have been obvious to use a G3 machine as the Internet fax provided in figure 1 of Iwazaki.

With respect to claim 19, figure 1 of Iwazaki clearly shows transmitting messages to an Internet Fax 6-8. It is not clear if the fax is a G2, G3 or G4 machine. However, since a fax machine is inclusive of a G4 machine, the Iwazaki reference contemplates the use of a G4 machine. Hence, it would have been obvious to use a G4 machine as the Internet fax provided in figure 1 of Iwazaki.

With respect to claims 34-36, Iwazaki teaches, Iwazaki teaches all of the subject matter upon which the claim depends. Iwazaki teaches a network 13 for performing the E-mail service and transmission over a GSTN, PSTN or ISDN.

Iwazaki teaches the aforementioned networks are art equivalents for the purpose of transmitting E-mail messages from a sender to a receiver and would have been contemplated by one of ordinary skill in the art.

The examiner submits that it would have been obvious to one of ordinary skill in the art to replace the Internet 13 with anyone of GSTN, PSTN or ISDN networks, known in the art, for the purpose of transmitting E-mail messages.

Furthermore, Iwazaki clearly shows transmitting messages to an Internet Fax 6-8. It is not clear if the fax is a G2, G3 or G4 machine. However, since a fax machine is inclusive of a G3 machine, the Iwazaki reference contemplates the use of a G3 machine. Hence, it would have been obvious to use a G3 machine as the Internet fax provided in figure 1 of Iwazaki.

With respect to claim 19, figure 1 of Iwazaki clearly shows transmitting messages to an Internet Fax 6-8. It is not clear if the fax is a G2, G3 or G4 machine. However, since a fax machine is inclusive of a G4 machine, the Iwazaki reference contemplates the use of a G4 machine. Hence, it would have been obvious to use a G4 machine as the Internet fax provided in figure 1 of Iwazaki.

4. Claims Objected

Claims 7, 8, 14-16, 18, 20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

5. **Claims Allowed**

Claims 21-28 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action.

Claims 21-28 are allowed for the reason the prior art does not teach or suggest a second delivery confirmation mail creating unit that creates a second delivery confirmation mail message notifying a result of the image information transmission by said Internet facsimile gateway device to the fax device after said image information transmission and a second delivery confirmation mail transmitting unit that transmits the second delivery confirmation mail message to the original address of said electronic mail message.”

Claims 38-45 are allowed for the reason the prior art does not teach or suggest in claimed combination, “... creating a second delivery confirmation mail message notifying a result of the image information transmission by said Internet facsimile gateway device to the facsimile device after said image information transmission; and transmitting the second delivery confirmation mail message to the original address of said electronic mail message.”

6. **Examiner's Remarks**

Applicant's arguments have been considered but are not persuasive to allow the claims.

Applicant argues at page 18, that the cited art does not disclose or suggest the claimed invention because, ".... According to Iwazaki, the apparatus will not recognize the capability request and its behavior is unpredictable." The examiner notes that there is no language in claim 1 that addresses a capability request and its behavior. Furthermore applicant contends that claims 1 and 29 are distinct over the present invention for the reason the prior art does not teach, "... wherein the image-information transmitting unit transmits image information included in an electronic mail message to a facsimile device by facsimile transmission over the telecommunication network **that is not the Internet.**"

Upon closer view, this limitation does not appear to be supported in the written specification nor in the drawings. At least figures 1-3, 12 and 13 suggests that an electronic message is transmitted directly over the Internet. See the diagram where data is traveling through Internet 101. Moreover, page 41 lines 1-5 of the specification

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suggests that transmission is over the Internet. The specification does not support that transmission is not over the Internet.

7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

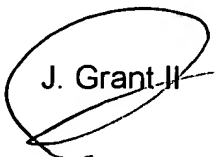
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8.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 571-272-7463. The examiner can normally be reached on Mon-Thur. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A Williams, can be reached on 571-272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "J. Grant II", is enclosed within a hand-drawn oval.

JEROME GRANT II
PRIMARY EXAMINER